

REMARKS

By this amendment, claims 1, 2, 4-8, 10-12, 15, 21, 27, and 31 have been amended. Claims 1-29, 31, and 32 remain currently pending in the subject application.

A Request of Continued Examination (RCE) under 37 CFR § 1.114 is respectfully made.

Rejection of Claims 1-29, 31, and 32 under 35 U.S.C. § 103

Claims 1-29, 31, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaw et al. (U.S. Patent No. 6,199,106, herein after referred to as "Shaw"). This rejection is respectfully traversed.

Shaw discloses an electronic mail system with advertising. Shaw emphasizes the advantages of using an E-mail system to target advertising to off-line users over using an online system. The entire focus of Shaw is concisely described in the title: "ELECTRONIC MAIL SYSTEM WITH ADVERTISING." It is respectfully submitted that Shaw does not teach or suggest targeting marketing content to online users. It is further respectfully submitted that does not teach or suggest *comparing* information derived from user's photographic likeness, to a target profile associated with each content; and presenting the online user with marketing content *based on the comparison*.

Shaw discloses in the FIELD OF THE INVENTION at column 1, lines 8-11: "The present invention is directed to an electronic mail system that displays advertisements to remote users, and in particular, to a system that displays targeted

advertisements to remote users when the users are off-line."
(Italicizing added for emphasis.)

In the BACKGROUND OF THE INVENTION, Shaw discloses in column 1, lines 22-26: "E-mail communication systems are generally regarded as multi-cast store-and-forward bi-directional communication systems. A user can send e-mail messages to one or more recipients at a time. An e-mail system is regarded as bi-directional as, usually, a user can both send and receive e-mail messages." In fact, the entire BACKGROUND OF THE INVENTION section is devoted to a discussion of the advantages of using an e-mail because "users read and write e-mail messages when off-line (e.g., when not connected to the on-line network)." See column 2, lines 7-9 and 36-38.

In the SUMMARY OF THE INVENTION Shaw discloses in column 3, lines 6-7: "The present invention is directed to a disconnected electronic mail system that displays targeted advertisements. More particularly, the present invention allows users to view advertisements while receiving, composing, and managing personal electronic communications." Contrary to the interpretation given in the Office Action, the foregoing passage means that the Shaw invention allows off-line users to view advertisements. In fact, the entire SUMMARY OF THE INVENTION section emphasizes the advantages of allowing the user to review the advertising and to decide on whether to purchase goods based on such advertising while the user is off-line. See, for example, column 3, lines 17-22; column 4, lines 41-46 and 53-58; column 4, line 59; column 5, line 2; column 5, lines 24-31 and lines 56-67.

Also in the SUMMARY OF THE INVENTION, Shaw discloses in column 7, lines 23-59: "The advertisements displayed to users

are not correlated with a user's e-mail in anyway. Thus, the advertisements can be regarded as context independent. The e-mail messages come from a different source than that of the advertisements (e.g., the e-mail messages originate from other network users, while the advertisements originate from advertisers). Advertisements that are transferred to a client computer are not in anyway related to the content of the e-mail messages that may be transferred to or from the client computer. There need not be any correlation between the number of e-mail messages sent and/or received and the number of advertisements transferred to or stored at the client computer. In the representative embodiment, advertisements are stored at the client computer in a different subdirectory to that of e-mail messages, and are not linked to any particular e-mail message or messages. Control of the display of e-mail messages is independent to that of the control of the display of advertisements--the client program determines which advertisements to display and at what times, whereas the user determines which e-mail message to read and when to read and write e-mail messages. The content of the e-mail message that is read or written by a user is unrelated to the content of any advertisement that is displayed, e.g., a user could be reading an e-mail message about a vacation in Paris and the advertisement which is displayed may be for shampoo."

Because Shaw teaches that there is no correlation between a user's e-mail and the advertising, Shaw does not suggest collecting data describing the user in a user profile, comparing the information in the user profile to a target profile, and then presenting the online user with content

based on such a comparison as specified in the claims of the subject application.

Shaw provides in an electronic mail system, a method to output at least one of (a) an advertisement, (b) a plurality of additional content portions representing a plurality of advertisements and (c) information other than an electronic mail message that is sent between a plurality of user's local computers through the remote system to a user at a local computer when the user's computer is off-line. The key to the method taught by Shaw is to output the advertisement at the user's computer while the user's computer is off-line with respect to the remote system. Such a method has absolutely no similarity to that of the Applicant's method and system.

It is respectfully submitted that the Office Action has not referred to a single column or line in the Shaw reference that discloses any of the steps of the Applicant's method. This is true even without relying on its lack of any reference to "including a photographic likeness of the user". The fact that in addition Shaw contains no mention of anything remotely similar to marketing content that includes a user's photographic likeness or image makes this reference even less pertinent. As stated in the previous response, the remarks of which are incorporated herein by reference, Shaw only briefly mentions the term "pictures" along with "sound recordings, formatted documents, etc." in the Background of the Invention section in column 1, lines 24-26. The use of pictures in this context merely exemplifies the type of information that persons using a computer commonly send via e-mail messages. There is no correlation to the advertising being targeted to the user.

Shaw discloses and claims an entirely different method from the Applicant's claimed invention, which is directed to online users. Shaw discloses using the user profile to maximize potential advertising time by displaying messages to a user at a client computer that includes a software program of the remote system when the client computer is "off-line" from the server system. The "off-line" user reads e-mail messages transferred to the client computer that includes banner advertisements based on the user profile.

Shaw does not compare information derived from a photograph and present an online user with marketing content based on the comparison.

The Office Action continues to maintain in the Final Rejection that it would have been obvious at the time the Applicant's invention were made to one of ordinary skill in the art in view of Shaw to select user's photographic likeness information because such a selection *"... allows users to view advertisements while receiving, composing, and managing personal electronic communications."* This is found in Shaw at col. 3, lines 5-10, the paragraph from which this passage is taken is quoted above. The foregoing passage simply refers to the fact that an off-line user can view the advertisement at the user's own time and convenience while receiving e-mail and then the user at some time in the future can compose, i.e., write, e-mail messages that are sent back to the remote system.

The Office Action also maintains that impermissible hindsight has not been gained on reading the Applicants' invention to come up with such an obviousness rejection. The Office Action states that simply relying on the knowledge of

one skilled in the art would modify the teachings of Shaw and combine it with such knowledge to come up with the limitations of the present invention. The Office Action refers to *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989) for a recitation of the well settled law that even non-preferred embodiments of a reference may be relied upon in a § 103 rejection. As emphasized in this response, Shaw's prohibition of correlating any information sent by the user with the advertisements falls into the category of a reference teaching away from the Applicant's invention, not simply a reference containing a non-preferred embodiment.

The Office Action also refers to *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) for the proposition that hindsight reasoning is permissible if it only takes into account knowledge within the level of ordinary skill at the time the invention was made. Applicant respectfully disagrees. One of ordinary skill in the art to which the Applicant's invention relates must go against the teaching of the Shaw reference and make a comparison of at least the online user's image information and present to the online user the marketing content based on such a comparison that includes the image.

The Office Action quotes from *In re Kotzab*:

"The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art."

This citation is inapplicable to the present case. In fact, the Federal Circuit went on in the same case to state:

"In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting claims 1, 2, and 4-9 under 35 U.S.C. § 103(a) over Evans. Moreover, because the rejections of claims 3 and 10 rely upon the foregoing, we also conclude that the Board did not make out a proper prima facie case of obviousness in rejecting those claims under 35 U.S.C. § 103(a).

The problem solved by the presently claimed invention Applicant is to how to successfully market content to online users. The problem solved by the Shaw is how to supply advertisements to users while they are off-line as discussed in great detail above. The solution reached by the Applicant is to have at least information derived from the image sent in by the online user compared with the target profile associated with the marketing content and to present to the online user the marketing content based on the comparison that must include the user's image. As stated above, it is impossible for the problem faced by the Applicant to be solved by anything remotely suggested by Shaw because of the stated prohibition against comparing anything sent in by the user

with the advertisements that is sent to the user for off-line viewing.

The Office Action cites the first sentence from the following paragraph of *In re Roeffett*, 149 F.3d 1375 at page 1375:

This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. In this case, the Board relied upon none of these. Rather, just as it relied on the high level of skill in the art to overcome the differences between the claimed invention and the selected elements in the references, it relied upon the high level of skill in the art to provide the necessary motivation. The Board did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely invoked the high level of skill in the field of art. If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

In the present case, there is no combination of references. The nature of the problem solved by the Applicant is entirely different from that of Shaw. The teaching of the only cited reference directs one skilled in the art to operate in a completely contrary manner to that required in the presently claimed invention.

The Office Action asserts that the Applicant was silent with respect to the dependent claims in not making a demand for a citation of references. The following was included in the previous response:

"The fact that Shaw does not suggest the use of such images certainly means that this reference is also silent on altering the images by the remote system to incorporate a portion of the content into the photographic image for display to the user as recited in claims 4, 5, 6, 7, 10, 11, 12, 17, 19, 24, 25, 31 and 32."

Certainly it is implicit in the foregoing paragraph that the Applicants are demanding a citation of a reference or combination of references to describe or suggest such features to maintain a rejection under 35 U.S.C. § 103(a) if Shaw, the only relied on reference, is stated as being silent on the features shown in the dependent claims as well as independent claims.

It is further respectfully submitted that Shaw does not disclose altering the photographic likeness of the user as called for in some dependent claims in the subject application.

Claim 1 calls for, among other things, comparing the user profile, including information derived from the photographic likeness, to a target profile associated with each content; and presenting the online user with marketing content based on the comparison. At least a combination of these and other elements specified in claim 1 is not taught or suggested by Shaw. Therefore, Shaw cannot make claim 1 obvious under 35 U.S.C. § 103.

Claims 2-14 depend from claim 1 and are therefore allowable over Shaw for at least the same reasons as claim 1. Claim 4 further sets out altering the photographic likeness to incorporate a portion of the content into the photographic likeness for display to the user. Claim 10 further sets out altering the photographic likeness to simulate the application of cosmetics on the user. Claim 11 further sets out selecting a color of the cosmetics based on the identified facial features. Claim 12 further sets out altering the photographic likeness to simulate the user wearing of jewelry. At least the combinations of theses and other elements specified in claims 4, 10, 11, and 12 are not taught or suggested by Shaw, further precluding the obviousness of claims 4, 10-12.

Claim 15 calls for, among other things, a program memory connected having program instructions stored therein for instructing the processor to perform comparing information derived from the associated user's photographic likeness and other information in the user profile, to the target profiles; and presenting the online user with the content associated with the target profiles. As respectfully pointed about, at least a combination of these and other elements specified in claim 15 is not taught or suggested by Shaw. Therefore, Shaw cannot make claim 15 obvious under 35 U.S.C. § 103.

Claims 16-20 depend from claim 15 and are therefore allowable over Shaw for at least the same reasons as claim 15. Claim 17 further sets out that the program memory further includes instructions for instructing the processor to perform the step of altering the photographic likeness to incorporate a portion of the content into the photographic likeness for display to the user. Claim 19 further sets out that the

photographic likeness is altered to simulate the application of cosmetics on the photographic likeness. At least the combinations of these and other elements specified in claims 17 and 19 are not taught or suggested by Shaw, further precluding the obviousness of claims 17 and 19.

Claim 21 calls for, among other things, comparing the user index to the target profile associated with each content; and presenting the online user with content based on the step of comparing. At least a combination of these and other elements specified in claim 21 is not taught or suggested by Shaw. Therefore, Shaw cannot make claim 21 obvious under 35 U.S.C. § 103.

Claims 22-26 depend from claim 21 and are therefore allowable over Shaw for at least the same reasons as claim 21. Claim 25 further sets out that the photographic likeness is altered to simulate the application of cosmetics on the photographic likeness. Claim 26 further sets out that the photographic likeness is altered to simulate the wearing of clothing. At least the combinations of these and other elements specified in claims 25 and 26 are not taught or suggested by Shaw, further precluding the obviousness of claims 25 and 26.

Claim 27 calls for, among other things, comparing the information derived from the associated user's photographic likeness and the context sensitive questions, to the target profile associated with each content; and presenting the online user with content based on the comparison. At least a combination of these and other elements specified in claim 27 is not taught or suggested by Shaw. Therefore, Shaw cannot make claim 27 obvious under 35 U.S.C. § 103.

Claims 28, 29, 31, and 32 depend from claim 27 and are therefore allowable over Shaw for at least the same reasons as claim 27. Claim 31 further sets out that the photographic likeness is altered to incorporate a portion of the content into the photographic likeness for display to the user. Claim 32 further sets out that the photographic likeness is altered to simulate the application of cosmetics on the photographic likeness. At least the combinations of these and other elements specified in claims 31 and 32 are not taught or suggested by Shaw, further precluding the obviousness of claims 31 and 32.

CONCLUSION

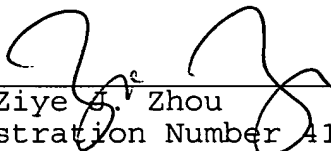
In view of above, claims 1-29, 31, and 32 currently pending in the subject application are believed to be allowable and the subject application is in condition for allowance. Such action is respectfully requested.

A Request of Continued Examination (RCE) under 37 CFR § 1.114 is respectfully made.

The Commissioner is hereby authorized to charge any additional fees to Manatt, Phelps & Phillips' Deposit Account No. 50-1847 or to credit any overpayment to the same for all matters during the prosecution of the subject application.

Respectfully submitted,

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Date: February 2, 2004

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